REMARKS

Claims 1, 7-9 and 19 are amended; claims 2-6 and 20 are canceled. New claim 21 is added. Support is found, for example, at page 3, lines 12-20, page 16, lines 15-18, pages 31-37 and in the original claims. No new matter is presented.

I. Petition to Withdraw Finality of the Action dated April 29, 2008

Applicants note that a Petition to Withdraw Finality of the Office Action dated April 15, 2008 was filed on June 13, 2008, which has not been acted on by the Office as of this date. Applicants maintain that the finality of the Office Action dated April 15, 2008, was improper and respectfully request withdrawal of finality of the Action for the reasons set forth in the Petition filed June 13, 2008, which are incorporated herein by reference.

In an effort to advance prosecution, Applicants provide the following in response to the Action dated April 15, 2008.

II. Response to Claim Rejection under 35 U.S.C. § 112, 1st Paragraph

In paragraph 7 of the Office Action, claim 19 is finally rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for treatment of some neurodegenerative disorders, allegedly does not reasonably provide enablement for prevention of any disorder or treatment of disorders such as brain cancer or Down's Syndrome.

Claim 19 is amended by deleting the recitation of "prevention and/or". Thus, amended claim 19 recites a method for treating a neurodegenerative disease.

Regarding the recitation of "a neurodegenerative disease", Applicants submit that neurodegenerative disease is described as including all diseases which are accompanied by degeneration of nerve cells and neuropathy. See page 28, lines 25-27. Specific examples of

neurodegenerative diseases are provided at page 29 and neuropathy is described as including all neurological dysfunctions at page 30. Examples of neuropathies are provided at page 30, lines 2-6. Additionally, at pages 42-43, the specification describes that the compounds of the present invention have the effects of improved physico-chemical property, such as intraoral acridity and lack of side effects, improved effect of astrocyte function, and improved effect of brain function and/or inhibitory effect of S100ß. It is further described that these effects are confirmed by methods described in EP0632008, EP1174131. Also, the pharmacological examples at pages 52-55 of the present specification provide confirmation of the effectiveness of the claimed compounds to improve the function of astrocytes. One of ordinary skill in the art could reasonably correlate the data showing the effectiveness of the claimed compounds of the present invention to improve the function of astrocytes to the treatment of neurodegenerative diseases and neuropathies described in the specification.

Applicants also submit that the present specification discloses that it has been confirmed that the claimed compounds are effective in the treatment of Parkinson's disease induced by MPTP in an experimental animal model. One of ordinary skill in the art could reasonably correlate the data showing the effectiveness of the compounds of the present invention in the treatment of Parkinson's disease induced by MPTP to the treatment of neurodegenerative diseases and neuropathies described in the specification.

Thus, in view of the knowledge in the art, state of the art, level of skill in the art and the guidance and working example provided in the present specification, one of ordinary skill in the art would be able to practice the claimed method without undue experimentation. Accordingly, Applicants respectfully request withdrawal of the §112, 1st paragraph, rejection.

III. Response to Claim Rejections under 35 U.S.C. § 102

Claims 1-3 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Manny et al. Claims 1-3, 5 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by English et al. Claims 1-4, 6 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dobner et al. Claims 1-4 and 6-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yoneda et al.

Claim 1 is amended herein by incorporating subject matter from claim 6 and by adding the recitation that (2R)-7-oxo-2-propyloctanoic acid is excluded as supported by the specification at page 16, line 16, wherein (2R)-7-oxo-2-propyloctanoic acid is disclosed. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See MPEP §2173.05.

None of the cited references discloses, teaches or suggests the compounds of the present invention. For at least this reason, claim 1 is not anticipated by any of the cited references.

Claims 2-6 are canceled herein, thereby rendering the rejection as to these claims moot.

Claim 7 is rewritten as an independent claim to recite a compound selected from the group consisting of (2R,7R)-7-hydroxy-2-propyloctanoic acid, (2R, 7S)-7-hydroxy-2-propyloctanoic acid and (2R)-8-hydroxy-2-propyloctanoic acid, a salt thereof or a prodrug thereof. None of the cited references discloses, teaches or suggests the compounds of the present invention. For at least this reason, claim 7 is not anticipated by any of the cited references.

Claim 8 depends from claim 1 or 7 and is distinguished for at least the same reasons as claim 1 or claim 7.

Claim 9 is amended by incorporating subject matter from claim 6. None of the cited references discloses, teaches or suggests the composition as recited in amended claim 9.

In the case of Yoneda et al, while Yoneda et al disclose (2R)-7-oxo-2-propyloctanoic acid, it does not disclose that (2R)-7-oxo-2-propyloctanoic acid can be used in a pharmaceutical composition. Therefore, the pharmaceutical composition comprising (2R)-7-oxo-2-propyloctanoic acid is not anticipated by Yoneda et al.

Regarding the Examiner's position that the compound of Yoneda et al itself represents a pharmaceutical composition with any residual traces of solvents and impurities corresponding to a carrier, claim 9 is amended herein by replacing the expression "pharmaceutically acceptable carrier or diluent" with --pharmaceutically acceptable additive agent-- as supported by the specification at pages 31-37. It is apparent that the pharmaceutically acceptable additive agent is different from residual traces of solvents and impurities. For this additional reason, claim 9 is not anticipated by Yoneda et al or any of the other cited references.

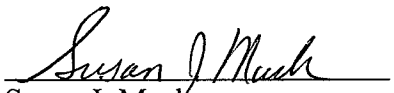
Accordingly, the present invention is not anticipated. Applicants respectfully request withdrawal of the §102 rejections.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: July 15, 2008